UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,973	06/20/2000	Arnold M. Lund	USW# 1743	6256

20350 7590 08/04/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
MANNING, JOHN	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/596,973	Applicant(s) LUND ET AL.	
	Examiner John Manning	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12,14-26,32 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12,14-26,32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 17 filed April 28, 2004 have been fully considered but they are not persuasive. Applicant has requested an express showing of documentary proof "that it is notoriously well known to receive caller identification information directly from the telephone system and display the caller identification information so as to identify the name and number of the person calling the user". The August et al. (US Pat No 5,671,267) discloses the use of caller identification information in conjunction with a remote input device. The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 and/or the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33).

2. Applicant's arguments with respect to claims 1-2, 8-10 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3-10 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. in view of Knowles et al. (US Pat No 6,505,348).

In regard to claim 1, the claimed limitation of "a display" is met by Figure 1, item 60. The claimed limitation of "a video source sending video to be displayed on the display" is met by Figure 2, Items 222-224. "Also shown as part of the base unit 20 is a modulator/demodulator coaxial circuit 222, a plug-in module 220, a modem 218 and an external input connector device 230. The modulator/demodulator coaxial circuit receives a signal from, for example, a video services network 40 over line 223 and provides this signal to a video receiving device such as display device 12 over line 224" (Col 5, Lines 58-64). The claimed limitation of "a remote generating a wireless signal for controlling the video source, the remote including a caller identification display for displaying caller identification information and at least one of a microphone and a speaker for telephone communication" is met by Figures 2, 3, and 5. The disclosed system is wireless. In "accordance with the disclosed embodiment, a cordless telephone portable unit or handset unit 10 which provides normal wireless communications with a cordless telephone base unit 20 and also provides two-way remote control functions for interacting with a plurality of remotely operated devices" (Col 2, Lines 28-33). The reference discloses the use of caller identification. The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 and/or the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33). The reference discloses the use of both a microphone and a speaker. "The receiver 114 also demodulates voice signals transmitted by the base unit 20 and couples these signals to a loudspeaker 121. The transmitter

113 has as its input both speech signals from a microphone 122 and data signals from the control unit 110 which it transmits to the base unit 20" (Col 5, Lines 15-20). The reference discloses "including a plurality of options for a user to select one or more locations to display caller identification information, one of the options comprising displaying the caller identification information on the remote." The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 **and/or** the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33). The reference fails to explicitly disclose implementing this option in the form of a menu. The Knowles reference teaches the use of a menu in conjunction with a caller ID system so as to facilitate the selection of system options.

> The Caller ID feature includes three major components:
> 1. A pop-up that displays over a TV state or any guide screen, which identifies somebody calling as the phone is ringing;
> 2. A menu that allows the user to configure the display options for the Caller ID pop-up; and
> 3. A list screen that shows a log of past callers. (Col 22, Lines 60-67)

Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement August with the use of a menu in conjunction with a caller ID system so as to facilitate the selection of system options.

In regard to claim 3, the claimed limitation of "remote selectively generates a wireless signal for changing the video to the display" is met by Figures 1 and 2. The "handset unit 10 functions as a capture device for receiving subliminal luminance data from a screen of a video receiving device 60 and also provides

the remote control functions for this video receiving device as well as a set-top box 30 associated with the receiving device" (Col 2, Lines 34-38).

Claim 4 is met by that discussed above for Claim 1.

In regard to claim 5, the claimed limitation "a telephone base unit in wireless communication with the remote" is met by Figure 1 and 2. In "accordance with the disclosed embodiment, a cordless telephone portable unit or handset unit 10 which provides normal wireless communications with a cordless telephone base unit 20 and also provides two-way remote control functions for interacting with a plurality of remotely operated devices" (Col 2, Lines 28-33).

In regard to claim 6, the reference discloses that the base unit is in communication with a telephone network (Fig 2, Item 211). "Referring next to base unit 20, there is shown a control unit 210 which interfaces with control unit 110 in the handset unit 10 for receiving the appropriate identification code data and for establishing a two-way communications link between the handset unit and the base unit. This control unit 210 also receives and processes opcode data provided by the handset unit 10 in dialing and providing tone signaling information out to a central office via telephone circuit 211 and tip-ring lines 201 and 202" (Col 6, Lines 35-43).

In regard to claim 7, the claimed limitation that "the video source is a subscription television decoder" is met by Set-top box 30. The "handset unit 10 functions as a capture device for receiving subliminal luminance data from a screen of a video receiving device 60 and also provides the remote control

functions for this video receiving device as well as a set-top box 30 associated with the receiving device" (Col 2, Lines 34-38). Set-top box 30 is a subscription television decoder.

In regard to claim 8, the video source provides both video and telephone communication (Figure 2, Items 211 and 222).

In regard to claim 9, the claimed limitation that "the main unit includes a subscription television decoder" is met by Figure 2. "Also shown as part of the base unit 20 is a modulator/demodulator coaxial circuit 222, a plug-in module 220, a modem 218 and an external input connector device 230. The modulator/demodulator coaxial circuit receives a signal from, for example, a video services network 40 over line 223 and provides this signal to a video receiving device such as display device 12 over line 224" (Col 6, Lines 58-64).

In regard to claim 10, the Knowles reference discloses the use of an Internet connection as shown in Figure 1A. "The data from various sources is merged at the data center headend in preparation to be sent to the network operators. The data is sent, using the FTP protocol, from the data center headend via the Internet 50 to the Download Server 60 of the network operator head end and then sent via hybrid fiber-coax 70 to an IPG device. The network operator headend receives the most recent schedule data whenever it downloads data from the data center headend" (Col 3, Lines 53-60).

In regard to claim 21, the claimed step of "displaying video on the display" is met by Figure 1, item 60. The claimed step of "providing an option to display caller identification information on the display and providing a second option to

display caller identification to display caller identification information on the remote" is disclosed in the reference. The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 **and/or** the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33). The reference fails to explicitly disclose receiving a user selection to display the caller identification information on a selected one of the display or the remote. The Knowles reference teaches the use of receiving a user selection via a menu, in conjunction with a caller ID system so as to facilitate the selection of system options.

> The Caller ID feature includes three major components:
> 1. A pop-up that displays over a TV state or any guide screen, which identifies somebody calling as the phone is ringing;
> 2. A menu that allows the user to configure the display options for the Caller ID pop-up; and
> 3. A list screen that shows a log of past callers. (Col 22, Lines 60-67)

Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement August with the use of receiving a user selection via a menu, in conjunction with a caller ID system so as to facilitate the selection of system options. The claimed steps of "determining that a telephone call is incoming to the information system" and "receiving caller identification information from the incoming call" are inherent to the system. The claimed step of "displaying the caller identification information on the selected one of the display or the remote" is disclosed. The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 **and/or** the display 325 of the handset

unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33).

In regard to claim 22, the claimed step of "transmitting the caller identification information to the remote prior to step f)" is inherent.

In regard to claim 23, the claimed step of "displaying the caller identification information on the remote" is met by Figure 5. The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 and/or the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33).

In regard to claim 24, the claimed step of "controlling the video on the display by sending a wireless signal from the remote" is met by Figures 1 and 2. The "handset unit 10 functions as a capture device for receiving subliminal luminance data from a screen of a video receiving device 60 and also provides the remote control functions for this video receiving device as well as a set-top box 30 associated with the receiving device" (Col 2, Lines 34-38).

In regard to claim 25, the claimed step of "changing the video on a display with a wireless remote" is met by Figures 1 and 2. The "handset unit 10 functions as a capture device for receiving subliminal luminance data from a screen of a video receiving device 60 and also provides the remote control functions for this video receiving device as well as a set-top box 30 associated with the receiving device" (Col 2, Lines 34-38). The claimed step of "communicating on the telephone call via and audio transducer on the remote" is met by Figure 2. The "multiple base units may be suitably configured for operation with the handset

unit, or other remotely operated devices may have the telephone functionality of a base unit incorporated therein for operation with the handset unit" (Col 4, Lines 50-54).

In regard to claim 26, the examiner interprets the claimed step of "providing an option to provide communication via the audio transceiver on the remote or an audio transceiver on the display" to be written in the alternative such that the claimed limitation may be met by either providing communication via the audio transceiver on the remote or an audio transceiver on the display. Accordingly, the limitation of providing communication via the audio transceiver on the remote is met by Figure 2, Items 121 and 122. The examiner interprets the claimed step of "receiving a selection of one of the remote or display in response to said providing the option" to be written in the alternative such that the claimed limitation may be met by either receiving a selection of the remote or display in response to said providing the option. Accordingly, the selection of the remote is inherent to the system. The claimed step of "communicating on the telephone call via the selected one of the audio transceiver on the display or the remote" is met by Figure 2. The "multiple base units may be suitably configured for operation with the handset unit, or other remotely operated devices may have the telephone functionality of a base unit incorporated therein for operation with the handset unit" (Col 4, Lines 50-54).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over August et al. is view of August et al. in view of Makhlouf (US Pat No 6,292,172).

In regard to claim 2, the August reference discloses a cordless telephone with remote control features. The reference fails to explicitly disclose that the remote is a wireless keyboard. Maklouf teaches the use of a remote that is a keyboard so as to allow general letter input and to facilitate direct Internet access. The "system is used in connection with a remote control that has a QWERTY type keyboard. The functions of the keyboard can be switched from general letter input to functions that directly access Internet addresses, sections within an Internet site, or television channels in television mode" (Col 3, Lines 50-54). Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Pope such that the remote is a keyboard so as to allow general letter input and to facilitate direct Internet access.

6. Claims 17-18, 32, 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope.

In regard to claim 17 and 18, the claimed limitation of at least one user input device is met by Figure 1, Item 10. The claimed limitation of a transmitter for generating a wireless signal for controlling an information system component based upon activation of the at least one user input device is met by Figure 1, Items 10 and 28. "The base unit 12 is used to transmit and receive voice data to and from the handset. The base unit 12 is connected to the telephone line 34 to receive the analog telephone signal, convert it to a digital signal, and transfer it to the handset, as well as receiving the digital signal from the handset and converting it to an analog signal sent on the telephone line 34" (Col 3, Lines 29-34). The reference fails to explicitly disclose receiving and displaying caller

identification information on the remote. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to receive caller identification information directly from the telephone system and display the caller identification information so as to identify the name and number of the person calling the user. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Pope with a receiver receiving caller identification information directly from the telephone system and a display displaying caller identification information on the remote for the stated advantage.

In regard to claims 32 and 12, the disclosed "audio transducer" includes a microphone and a speaker for telephone communication (Figure 1, Item 10). "The handset 10 is a cordless digital telephone handset. It includes speakers 24 and 26, an antenna 28, a keypad 30, and a display 32" (Col 2, Lines 46-48).

In regard to claim 14, the "transmitter" controls an entrainment system component. "Appliances that are controlled by the infrared signals include television 14, cable controller 16, and compact disc player 18" (Col 4, Lines 1-3). "The appliance control codes are stored in a memory 66. Memory 66 can be a read-only memory (ROM), or can be a random-access memory (RAM). Display 68 and keypad 70 can be used to select an appliance control code out of the memory 66. The appliance control code can be transmitted through the transmitter 52 to the base unit" (Col 4, Lines 28-33). The transmitted appliance control code is the "second wireless signal".

In regard to claim 15, the Pope reference discloses a cordless telephone with remote control features where the remote control features control a

television as well as other appliances. The reference fails to explicitly disclose that the wireless signal changes a video source to the display. However, the examiner takes OFFICIAL NOTICE that it is notoriously well known to have a remote with the feature of changing a video source to a display so as to allow the user to conveniently change video sources. Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Pope with the feature of changing a video source to a display for the stated advantage

7. Claims 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of Makhlouf (US Pat No 6,292,172).

In regard to claim 16, the Pope reference discloses a cordless telephone with remote control features. The reference fails to explicitly disclose that the remote is a wireless keyboard. Maklouf teaches the use of a remote that is a keyboard so as to allow general letter input and to facilitate direct Internet access. The "system is used in connection with a remote control that has a QWERTY type keyboard. The functions of the keyboard can be switched from general letter input to functions that directly access Internet addresses, sections within an Internet site, or television channels in television mode" (Col 3, Lines 50-54). Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Pope such that the remote is a keyboard so as to allow general letter input and to facilitate direct Internet access.

In regard to claim 19, the Pope reference discloses a cordless telephone with remote control features. The reference fails to explicitly disclose that the remote is a wireless keyboard. Maklouf teaches the use of a remote that is a

keyboard so as to allow general letter input and to facilitate direct Internet access. The "system is used in connection with a remote control that has a QWERTY type keyboard. The functions of the keyboard can be switched from general letter input to functions that directly access Internet addresses, sections within an Internet site, or television channels in television mode" (Col 3, Lines 50-54). Consequently, it would have been clearly obvious to one of ordinary skill in the art to modify Pope such that the remote is a keyboard so as to allow general letter input and to facilitate direct Internet access.

In regard to claim 20, the Makhlouf reference discloses that keyboard generates the wireless signal to control the information system component by sending character information. "The keypad 116 of the universal remote control unit 50 enables the specification of Internet addresses and other textual information. The remote control unit 50 includes a number of function keys 124 that enables the selection of various functions" (Col 10, Lines 44-48).

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of August et al.

In regard to claim 33, Pope discloses a digital control telephone with remote control features. The reference fails to explicitly disclose the user configuration of the display location of the caller ID information. August teaches the user configuration of the display location of the caller ID information so as to increase functionality. The August reference discloses "including a plurality of options for a user to select one or more locations to display caller identification information, one of the options comprising displaying the caller identification

information on the remote." The "number of the calling party may be displayed in a captioned manner on the video receiving device 60 **and/or** the display 325 of the handset unit 10 while the telephone is ringing, thereby permitting call screening for a user" (Col 10, Lines 29-33). Consequently, it would have been clearly obvious to one of ordinary skill in the art to implement the Pope reference with user configuration of the display location of the caller ID information so as to increase functionality.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 703-305-0345. The examiner can normally be reached on M-F: 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM
July 23, 2004

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600